

Remarks/Arguments

The present application was filed October 17, 2001 with original claims 1-20. The Office Action mailed March 19, 2004 provided a three-way restriction/election requirement, and rejected claims 1-8 and 20 which are all the pending claims of the provisionally elected group I claims.

Restriction/Election Requirement

The Applicant provisionally elected the claims of Group I with traverse. The Applicant respectfully submits the restriction/election requirement is erroneous as a matter of law.

As originally filed, the Group I and Group II claims are related as process and product-by-process, the latter reciting the same method steps as the process. Accordingly, the process steps of Group I are required by the product-by-process of Group II. Accordingly, the process of Group I claims can likewise be performed without any repetition of steps. The Group I and Group III claims are related as genus and species. Contrary to the Examiner's assertion, the aligning step of Group I claims is required in the Group III claims as well.

Nevertheless, the restriction/election requirement is moot in view of the amendments to the claims made herein. Independent claim 1 is now drawn to a method comprising obtaining a disc comprising servo pattern information written in relation to an angular reference axis, placing the disc around a motor hub, and biasing the disc against the motor hub in relation to the angular reference axis. Claims 18 and 10 are drawn to combination and subcombination, respectively, apparatus claims reciting the limitations of the method claim 1.

Withdrawal of the restriction/election requirement is respectfully requested.

Rejection of Claims Under 35 U.S.C. §112 Second Paragraph

Claims 1-8 and 20 were rejected for indefiniteness. This rejection is respectfully traversed.

Claim 1 was rejected for the phrase "the position" lacking antecedent basis. Claim 1 has been amended to delete this phrase.

Claims 2, 3, and 4 were rejected because the phrase "the number of discs" is unclear as to whether it refers to a new set of discs or the previously referred to "a number of discs." Claims 2, 3, and 4 have been amended to delete the phrase "the number of discs."

Claim 2 was rejected because it recites one disc, while the Examiner read claim 1 to recite a plurality of discs. The Applicant respectfully traverses the Examiner's construction of originally submitted claim 1 as requiring a plurality of discs. Nevertheless, the amendments to claim 1 more particularly point out and distinctly claim the subject matter of claim 1.

The amendments to claims 1-4 obviate the Section 112 rejection. Reconsideration and withdrawal of this rejection are respectfully requested.

Rejection of Claims Under 35 U.S.C. §102(b)

Claims 1-6 were rejected as being anticipated by Morehouse '572. This rejection is respectfully traversed.

Morehouse '572 does not disclose at least the following novel feature of the embodiments of the present invention as recited by the language of claim 1: "*biasing the disc against the motor hub in relation to the angular reference axis.*"

First, Morehouse '572 discloses the alignment feature to be the result of, not the object of, the biasing step. The Examiner construes the inner hole surface of the disks

40, 41 in Morehouse '572 as reading on the "*disc alignment mark*" of original claim 1. Amended claim 1 more particularly defines the structural relationship between the servo pattern information and the "*angular reference axis*." The inner hole surface of Morehouse '572 does not read on the "*angular reference axis*." Rather, the "*angular reference axis*" defines the point-contact between the inner hole surface and the motor hub that results from the biasing step. More particularly, from the specification: "The alignment mark 134 is located near an inner diameter of the prewritten disc 108 at a same angular position as a disc-to-hub contact point 138, which is at an inner diameter of the prewritten disc 108." (page 5, lines 31-33)

Second, the Examiner construes the biasing step as reading on the forces applied by springs 24a, 24b in Morehouse '572. However, a plain reading of Morehouse '572 reveals these springs pressingly engage the clamps 23, 24 against the surfaces 32, 33 of the housing 31, which is completely remote from and does not affect the relationship between the disk 40, 41 and the spindle 34 in Morehouse '572. Morehouse '572 is, in fact, silent regarding biasing the disks 40, 41 to prevent repeatable runout in accordance with the embodiments of the present invention.

Morehouse '572 cannot sustain the Section 102 rejection because it does not identically disclose all the recited features of the present invention according to the language of claim 1. Accordingly, the Applicants respectfully submit that the Section 102 rejection of claim 1 as being anticipated by Morehouse '572 is erroneous as a matter of law, and request withdrawal of the rejection and allowance of claim 1 and the claims depending therefrom.

Rejection of Claims Under 35 U.S.C. §103(a)

Claims 7, 8, and 20 were rejected as being obvious over Morehouse '572 in view of Horning '735. These claims have been amended to delete the recital to manufacturing method features, obviating the present rejection. Reconsideration and withdrawal of the rejection of these claims, in light of the amendments and the reasons above, are respectfully requested.

Nonelected Claims

As requested above, the restriction/election requirement is erroneous as a matter of law. Nonelected independent claims 10 and 18 are allowable over the cited references for the same reasons as discussed for claim 1 above. Withdrawal of the restriction/election requirement and passage of all claims 1-20 to issuance are respectfully requested.

Conclusion

This is a complete response to the Office Action mailed March 19, 2004. The Applicants request reconsideration and passage to allowance all pending and nonelected claims. The Examiner is invited to contact the Attorneys listed below should any questions arise concerning this response.

Respectfully submitted,

By: 

Mitchell K. McCarthy, Registration No. 38,794

Randall K. McCarthy, Registration No. 39,297

Bill D. McCarthy, Registration No. 26,772

Fellers, Snider, Blankenship, Bailey and Tippens, P.C.

Bank One Tower

100 N. Broadway, Suite 1700

Oklahoma City, Oklahoma 73102

Telephone: (405) 232-0621

Facsimile: (405) 232-9659